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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,853	08/13/2001	Martin Melchior	Mo-6476/LeA 34,678	8274
157	7590	09/17/2004		
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205				
			EXAMINER SERGENT, RABON A	
			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,853

Applicant(s)

MELCHORS ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2004 has been entered.
2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 8 fails to further limit claim 1, as amended. Claim 1 fails to provide for the addition of the polyisocyanate to the polyol during the conversion thereof to the aqueous phase.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. ('393) in view of EP 159117.

Blum et al. disclose water dispersible binder compositions comprising a urethane modified polyester polyol, derived from reactants that overlap those of applicants, and a blocked polyisocyanate component. See abstract and columns 3-6.

5. Though Blum et al. disclose numerous blocking agents for masking the polyisocyanate, patentees are silent regarding the use of pyrazole blocking agents. Still, the use of pyrazoles as blocking agents for polyisocyanates that are to be incorporated into aqueous compositions in masked form was known at the time of invention. This position is supported by the teachings of EP 159117 at page 4, lines 4+. Additionally, the secondary reference discloses that a benefit of using the pyrazole blocking agents is that the deblocking temperature is significantly lower as compared to the deblocking temperature of other conventional blocking agents. Since lower deblocking temperatures require less energy input and, therefore, require less expense, the position is taken that it would have been obvious to utilize the pyrazole blocking agents within the primary reference, so as to obtain a coating system that is less expensive to apply.

6. Applicants have argued that the examiner's motivation is lacking, because one skilled in the art would not look to coatings that cost less to apply in order to discover blocked isocyanate resins that do not yellow and are storage stable. In response, a proper motivation to modify the prior art need not parallel applicants' reasoning to make the claimed invention. Accordingly, the motivation set forth by the examiner is proper. Applicants have further argued that one of ordinary skill would not have been motivated to combine the teachings of the primary reference with the teachings of the secondary reference, because one reference is drawn to stoving

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compositions and the other is drawn to electrodeposition coatings. This argument is not found persuasive, because the coatings are considered to be closely related in that both types of aqueous urethane coatings rely upon essentially the same chemistry for curing and differ primarily in the means of application. The skilled artisan would have immediately noted the parallels between the two coating systems and would have found it obvious to combine the teachings of the references. Furthermore, it is noted that Blum et al. disclose at column 6, lines 14-17 that the urethane modified polyester resins perform the function of an emulsifier for the crosslinker resins, this disclosure parallels applicants' remarks at page 6 of the response that the instant polyols serve as emulsifiers for the blocked polyisocyanate. In view of this teaching within Blum et al., one of ordinary skill would have reasonably expected that stable aqueous dispersions comprising urethane modified polyester polyols and a broad range of blocked isocyanates can be produced.

7. Furthermore, applicants' argument that the instant claims differ from the prior art because the prior art requires that the urethane modified polyester be aqueously dispersed prior to addition of the blocked isocyanate (crosslinking agent) is not well taken for the following reasons. Firstly, applicants' argument and declaration are not adequately representative of the prior art, because the prior art does not require that the crosslinking agent be added after formation of the dispersion. Blum et al. disclose at column 7, lines 16-19 that the binder compositions may be prepared simply by mixing components a), b), and c); given the description of these components within the reference, it appears clear that water is not a required component of any of components a), b), or c). Therefore, despite applicants' response, it cannot be said that Blum et al. require that the crosslinker be added after formation of the aqueous dispersion, and

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for this reason, it is not seen that applicants' amendment of August 13, 2004 to claim 1 distinguishes the instant claims from the prior art.

8. Lastly, the 37 CFR 1.132 declaration of July 1, 2004 has again been considered; however, despite applicants' arguments, the position is maintained that applicants' declaration is deficient, because it is not commensurate in scope with the instant claims in terms of polyol and polyisocyanate composition. The declaration utilizes a polyester polyol and an aliphatic polyisocyanate, whereas the instant claims are not so limited.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 14, 2004


RABON SERGENT
PRIMARY EXAMINER